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09/986,354	11/08/2001	Matthew George Majikes	52493.000187	5302

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10/07/2010

EXAMINER

RINES, ROBERT D

ART UNIT	PAPER NUMBER
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3623

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/986,354	Applicant(s) MAJIKES ET AL.	
	Examiner R. David Rines	Art Unit 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 23-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 23-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

[1] A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 13 July 2010 has been entered.

Notice to Applicant

[2] This communication is in response to the Amendment and the Request for Continued Examination (RCE) filed 13 July 2010. Claim 22 has been cancelled. Claims 1, 15, 25, and 29 have been amended. Claims 1-21 and 23-30 are pending.

NOTE: Pending claims 1-21 and 23-30 have been amended in response to previously issue rejection(s) of the subject claims. the amendments do not alter the functions steps/elements as to require re-consideration of the prior art rejections set forth in the prior Office Action mailed 13 April 2010. Accordingly, rejections are maintained herein below.

Claim Rejections - 35 USC § 101

5 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Previous rejection(s) of claims 1-14, and 29-30 under 35 U.S.C. 101 because the claimed invention is directed to nonstatutory descriptive material as maintained in the previous Office Actions mailed 3 February 2009 and 15 September 2009, are maintained herein.

Examiner recognizes that the subject claims indicate that selections are "...based at least in part on an input from a client station..." and in the remarks filed 13 July 2010 Applicant notes an embodiment of the invention in which the engine is a server. However, as amended, the recited "...client station..." is not a component of the system. Similarly, the recited engine is merely delineated as "associated" with the respective module and further as "being accessible over a network" and is therefore not positively recited as a system component. Absent a specific indication of a hardware component as integral to the recited module(s), the Specification indicates that embodiments exist that are comprised exclusively of software (as noted in the previous Office Actions). Accordingly, Applicant amendments have failed to overcome previous rejection under 35 U.S.C. 101.

Claims 2-14, 29, and 30 when analyzed in the same manner described above with respect to claim 1, are also rejected under 35 U.S.C. 101 as being directed to *software per se*.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[3] Claims 1-2, 4-7, 9-21, 23-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cullen et al., (United States Patent #6,272,528) in view of Herz et al. (United States Patent #5,835,087) and further in view of Jinnett (United States Patent Application Publication (#20020120477)).

As per claim 1, Cullen et al. disclose a system for personalizing and delivering insurance or financial services-related content to a user, comprising: a product or service selection module for selecting at least one insurance or financial services-related category or products or services the user is interested in (Cullen et al.; col. 5, lines 19-41 and col. 7, lines 16-67); a filtering module associated with an engine for (1) determining information about the user based on the interest in particular insurance products or policies (Cullen et al.; col. 1, lines 31-45, col. 3, lines 29-34, and

col. 5, lines 55-67), and (2) for personalizing and delivering the insurance or financial services-related content based on the information about the user (Cullen et al.; col. 1, lines 61-67, col. 6, lines 9-21, and col. 7, lines 16-67), the engine being accessible to the user over a communications network (Cullen et al.; Abstract, col. 3, lines 2-9, and col. 4, lines 1-35).

Cullen et al. fail to specifically indicate that the user's interest is "...based on the user's historical access pattern to particular insurance products or policies..." or that the products retrieved are "products or services the user is authorized to sell..."

With respect to these features, Cullen et al. teach the use of mobile agents that gather user information and preferences and subsequently collect information regarding insurance and financial products that is filtered to reflect the expressed interests of the user, Cullen et al. fail to disclose that user information and preferences are obtained via filtering the user's access behavior with regard to specific subjects or products that are of interest to the user. The user preferences are manually entered by an individual and retained by a "preferences agent".

Examiner notes that the claim as presently constructed recites an "engine" and then indicates an intended use for the engine which includes using user information to search for "products and services the user is authorized to sell" and "personalizing and delivering...at least one...insurance or product the user is authorized to sell...". Examiner submits that under the broadest reasonable interpretation of the above noted limitations, the agent-based search engine of Cullen et al. retrieves information from a stored profile which is used repeatedly each time a search is

performed and thus retrieves information based on the same or slightly modified user profile information each time (i.e., based on a historical access pattern). With respect to “user is authorized to sell” Examiner submits that any search engine (e.g. Cullen et al.) when used by an individual searching for products they can sell (e.g. an insurance agent searching the employer insurance company’s web content) would be aware of the companies with which the individual has a selling agreement and would use appropriate search terms to find "products the user is authorized to sell”.

Claim 1 has been amended with respect to the “product or service selection module” to specify that selections are made "...based at least in part on an input from a client station...".

The noted amendment has been made in effort to overcome rejections under 35 U.S.C. 101 and does not alter the scope and recited functions of the claim.

With respect to the "determining information" functions to further define the "user's historical access pattern" as "one or more products or policies that the user was interested in during a previous access to the system...", Cullen et al. fail to disclose filtering the historical access to products and services.

With respect to filtering an individual's access patterns to particular products and services, as is evidenced by Herz et al., filtering a user's browsing behavior, i.e., "access patterns" to generate an interest profile for the user that can be used to estimate the user's interest regarding other published material, is well-known in the electronic commerce and insurance/financial services art (Herz et al.; Abstract, col. 7, lines 47-67 and col. 17, lines 15-36).

With respect to the above noted limitation, Examiner respectfully submits that the filtering content of Herz et al., which is in accordance with an interest profile, is based on "...one or more products or policies that the user was interested in during a previous access to the system..." at least insofar as presently claimed by Applicant. Specifically, Herz et al. disclose assembly of an interest profile that is generated and improved over time based on articles accessed by the user (Herz; col. 7, lines 25-40, col. 58, lines 26-67, col. 59, lines 1-38). Examiner respectfully submits that the noted teachings indicate that the information delivery of Herz is directly related to information previously of interest to the user (see monitoring accessing of articles and updating profile).

Herz fails to disclose filtering with respect to products or service a user is "authorized to sell..."

Regarding filtering information in accordance with defining products the “user is authorized to sell”, as evidenced by Jinnett, it is well known in the e-commerce, insurance, and financial service art(s) to tailor or customize insurance and financial product information to such that it is in compliance with regulatory constraints that dictate the products that are authorized to be sold by a user or to a user in the user’s respective jurisdiction, (Jinnett; Abstract paragraphs [0025] [0038] [0103]-[0109]). Specifically, Jinnett disclose a system and method that presents insurance and financial service product information and customizes transactions to accommodate the jurisdiction of the user, i.e., “products the user is authorized to sell”, (Jinnett; paragraphs [0018] [0045] [0051] [0106]0[0108]).

Jinnett further discloses an administrative module/interface for inputting, updating and accessing user and product information (Jinnett; paragraphs [0099] [0103] [0109] *see updating and maintaining databases including products and user authentications, i.e., product information and user information).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the manual entry of user profile/preferences information of Cullen et al. with the filtering/access pattern-based profile of Herz et al. with the motivation and reasonable expectation of successfully directing subsequent queries to products and services that are relevant to the user’s interests without requiring the user to expend an excessive amount of time and energy searching for the information (Herz et al.; col. 1, lines 46-50 and col. 8, lines 1-7).

Further, it would have been obvious to one of ordinary skill in the art to have modified the particular preference settings and interest-based filtering of Cullen and Herz to customize deliverables (i.e., product and service information) to accommodate the legal/regulatory standards of the desired location (Jinnett; paragraph [0107]) with motivation and reasonable expectation of successfully ensuring that products offerings are made and transactions are conducted without violating the laws of the applicable jurisdiction (Jinnett; Abstract).

As per claim 2, Cullen et al. teach a system wherein the insurance or financial services-related content is delivered to the user over the communications network (Cullen et al.; col. 1, lines 61-67, col. 3, lines 2-9, and col. 6, lines 9-21).

As per claim 4, Herz et al. teaches a system wherein the insurance or financial services-related content delivered to the user is located at a URL address (Herz et al.; col. 38, lines 18-32 and col. 58, lines 26-56).

As per claim 5, Herz et al. teach a system wherein the insurance or financial services-related content is delivered to the user via mail delivery means (Herz et al.; col. 38, lines 18-32, and col. 58, lines 26-56).

As per claim 6, Herz et al. teach a system wherein the mail delivery means comprises the United States Postal Service (Herz et al.; col. 38, lines 18-32, and col. 58, lines 26-56 NOTE: Examiner considers the use United States Postal Service "USPS" to be a user choice).

As per claim 7, Herz et al. teach a system wherein the mail delivery means comprises express delivery service (Herz et al.; col. 38, lines 18-32, and col. 58, lines 26-56 *express mail is a user choice).

As per claim 9, Cullen et al. teach a system wherein the information about the user and the insurance or financial services-related content are stored in a database (Cullen et al.; col. 3, lines 10-15, col. 6, lines 32-34 and col. 7, lines 42-44).

As per claim 10, Cullen et al. teach a system wherein the information about the user comprises the user's identity (Cullen et al.; col. 3, line 42 and col. 5, lines 33-41).

As per claim 11, Cullen et al. teach a system wherein the information about the user comprises log-in information such as user name and password (Cullen et al.; col. 4, lines 1-34).

As per claim 12, Cullen et al. teach a system wherein the insurance or financial services-related content comprises information about insurance products and services available to the user (Cullen et al.; col. 3, lines 10-15 and col. 7, lines 13-15).

As per claim 13, Cullen et al. teach a system wherein the insurance or financial services-related content comprises literature about insurance products and services available to the user (Cullen et al.; col. 6, lines 9-21).

As per claim 14, Cullen et al. teach a system wherein the communications network comprises the Internet (Cullen et al.; col. 3, lines 2-9).

Regarding claims 2, 4-7, and 9-14, the statements of obviousness and motivation to combine as discussed with regard to claim 1 above are applicable to claims 2, 4-7, and 9-14 and are herein incorporated by reference.

Claim 15 substantially repeats the subject matter of claim 1. Accordingly, claim 15 as presently amended is rejected as obvious in consideration of Cullen et al., in view of Herz et al. and further in view of Jinnett for the reasons, conclusions of obviousness, and statements motivation as discussed above with respect to claim 1.

Claim 15 has been amended to overcome previous rejection of the claim under 35 U.S.C. 101, withdrawn herein, and has not been modified with respect to the function recitations addressed by the prior art under 35 U.S.C. 103(a). Accordingly, rejection(s) under 35 U.S.C. 103(a) for the reasons, conclusions of obviousness, and statements of motivation as set forth in the previous Office Action mailed 15 December 2009 are maintained herein.

As per claim 16, Cullen et al. teach a method wherein the insurance or financial services-related content is delivered to the user over the communications network (Cullen et al.; col. 1, lines 61-67, col. 3, lines 2-9, and col. 6, lines 9-21).

As per claim 17, Herz et al. disclose a method wherein the insurance or financial services-related content is delivered to the user via mail delivery means (Herz et al.; col. 38, lines 18-32 and col. 58, lines 26-56).

As per claim 18, Herz et al. disclose a method wherein delivering the insurance or financial services-related content comprises transferring the user to a URL address containing the insurance or financial services-related content (Herz et al.; col. 38, lines 18-32 and col. 58, lines 26-56).

As per claim 19, Cullen et al. teach a method wherein the information about the user comprises the user's identity (Cullen et al.; col. 3, line 42, and col. 5, lines 33-41).

As per claim 20, Cullen et al. teach a method wherein the user's identity is automatically determined upon the user accessing the filter module (Cullen et al.; col. 3, line 42, and col. 5, lines 33-41 and col. 4, lines 1-24).

As per claim 21, Cullen et al. teach a method where the user's identity is determined based on the user's username and password (Cullen et al.; col. 4, lines 1-35).

Claim 22 has been cancelled.

As per claim 23, Cullen et al. teach a method wherein the insurance or financial services-related content comprises literature relating to products and services available to the user (Cullen et al.; col. 6, lines 9-21).

As per claim 24, Cullen et al. teach a method wherein the information about the user is stored in a database (Cullen et al.; col. 6, lines 32-34 and col. 7, lines 42-44).

Regarding claims 16-21 and 23-24, the statements of obviousness and motivation to combine as discussed with regard to claim(s) 15/1 above are applicable to claims 16-21 and 23-24 and are herein incorporated by reference.

Claim 25 substantially repeats the subject matter of claim 1 and has been amended to include the subject matter presented by claim 1. Accordingly, claim 25 as presently amended is rejected as obvious in consideration of Cullen et al., in view of Herz et al. and further in view of Jinnett for the reasons, conclusions of obviousness, and statements motivation as discussed above with respect to claim 1.

As per claim 26, Cullen et al. teaches a method wherein the insurance or financial services-related content is received over the communications network (Cullen et al.; col. 1, lines 61-67 and col. 3, lines 2-9 and col. 6, lines 9-21).

As per claim 27, Cullen disclose a method wherein the insurance or financial services-related content is received via mail delivery means (Cullen et al.; col. 1, lines 61-67 and col. 3, lines 2-9 and col. 6, lines 9-21 NOTE: see "address").

As per claim 28, Cullen et al. teaches a method wherein the insurance or financial services-related content comprises information about insurance products and services available to the user (Cullen et al.; col. 3, line 10-15, and col. 7, lines 13-15).

Regarding claims 26-28, the obviousness and motivation to combine as discussed with regard to claim 25 above are applicable to claims 26-28 and are herein incorporated by reference.

As per claim 30, Cullen and Herz fail to disclose a system wherein products and services the user is authorized to sell is based at least in part on the user's location.

However, Jinnett discloses a system wherein products and service the user is authorized to sell is based in part on the user's location (Jinnett; paragraphs [0018] [0045] [0051] [0106]0[0108]).

Regarding claim 30, the obviousness and motivation to combine as discussed with regard to claim 1 above are applicable to claim 30 and are herein incorporated by reference.

[6] Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cullen et al., Herz et al., and Jinnett, as applied to claim 1 above, and further in view of Quido et al.

As per claim 3, although Cullen et al., teach delivering insurance or financial services-related content to a user via a computer network (Cullen et al.; Abstract), neither Cullen nor Jinnett, nor Herz specifically teach transmitting content in PDF format.

However, Quido et al., teaches a system wherein the insurance or financial services-related content is delivered in PDF format (Quido et al.; paragraphs [0095] [0101]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Cullen et al., Herz et al., and Jinnett, as applied to claim 1 above, with those of Quido et al. Such combination would have resulted in a system and method in which a mobile software agent obtains the details of a user's requirements, obtains financial information from the server computers on behalf of the user in light of the users requirements, and then delivers the financial information to the user (Cullen et al.; Abstract). The motivation to combine the teachings would have been store content in PDF format, a format that is well known in the art as evidenced by Quido et al., such that the documents could be made available to an online user (Quido et al.; paragraph [0095]).

[7] Claims 8 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cullen et al., Herz et al. and Jinnett as applied to claim 1 above, and further in view of Parker (United States Patent Application Publication #2003/0182290).

As per claim 8, Cullen et al., Jinnett, and Herz et al. fail teach scanning documents into the system.

However, scanning hardcopy documents for the purpose of computer storage is old and well known in the art as is evidenced by Parker (Parker; paragraph [0023]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Cullen et al., Herz et al., and Jinnett as applied to claim 1 above, with those of Parker. The motivation to combine the teachings would have been to employ a technique that is old and well-known in the art for the purpose of converting written documents into computer storable images (Parker; paragraph [0023]) such that scanned document images such as insurance policies, wills, medical histories etc., can be stored on the computer (Parker; paragraph [0023]).

Claim 29 differs from claim 1 with regard to the claimed administration module. Claim 29 further specifies the features of the claimed administration module to require "...wherein the administration interface includes scanning means for uploading insurance or financial services-related information". As per this element, Cullen et al., and Herz et al. fail to disclose and administration interface including scanning means.

While Jinnett teach a system wherein the administration interface serves in the uploading of insurance or financial services-related information, Jinnett fails to disclose scanning means for scanning hardcopy documents into the system.

However, as evidenced by Parker, it is well-known in the art to use a scanner to scan documents into electronic form such that they can be stored and accessed electronically (Parker; paragraph [0023]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Cullen et al., Jinnett., and Herz et al. as applied to claim 1 above, with those of Parker. It would have been obvious to have modified the interface of Cullen et al. to include well-known technologies for converting written documents into computer storable images (Parker; paragraph [0023]) with the motivation of enabling pertinent documents such as insurance policies, wills, medical histories etc. to be converted to electronic images so that they can be stored on the computer (Parker; paragraph [0023]).

Response to Remarks

Applicant's remarks filed 13 July 2010 have been fully considered but they are not persuasive. In the noted response, applicant substantially rehashes arguments previously addressed in the prior Office Action mailed 13 May 2010 and 15 September 2009. In response to the instant remarks, Examiner relies on the response set forth in the noted prior Office Actions incorporated by reference herein.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. David Rines whose telephone number is (571)272-5585. The examiner can normally be reached on 8:30am - 5:00pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on 571-272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. David Rines/
Primary Examiner, Art Unit 3623